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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,873	01/10/2002	Jeffrey Freedman	FREE-11	6290

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EXAMINER

YEUNG, GEORGE CHAN PUI

ART UNIT PAPER NUMBER

1761

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/043,873	Applicant(s) FREEDMAN, JEFFREY	
	Examiner George C Yeung	Art Unit 1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-57 ~~is/are~~ are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-25 ~~is/are~~ are allowed.
- 6) ☒ Claim(s) 26-45 and 47-57 ~~is/are~~ are rejected.
- 7) ☒ Claim(s) 46 ~~is/are~~ are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/6/02 and 6/9/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification Objections***

The specification is objected to because of the following informalities:

1. The same reference numeral "14" is improperly used to identify three different structures or parts, i.e. the center opening (see page 7, lines 18-19 and page 9, line 20), the cover (see page 8, lines 1, 2 and 4) and the top (see page 8, line 6 and page 9, line 4). No single reference numeral can be used for two or three different parts. See MPEP section 608.01 (g).
2. The same reference numeral "2" is improperly used to identify both the baffle (see page 8, line 11) and the upper screen portion (see page 8, lines 12-13). Correction is required.

### ***Drawing Objection***

Figure 1 is objected to because a single reference numeral "14" is used for the removable cover and the central opening. Correction is required.

### ***Claims Rejections –35 USC § 112, SECOND PARAGRAPH***

Claims 39 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the following reasons:

It is not clear what structure is intended by the limitation "the mass of beans emits smoke with said chamber when roasting" recited in claim 39 and the limitation

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“when generating slow speed airflow draws in ambient air and exhausts air and smoke from the chamber to enable the operator to visually inspect the color and condition of the roasting beans of said mass of beans while the mass of beans is at rest on said surface” recited in claim 40. Note that the limitations recited in claims 39 and 40 are method limitations and thus they fail to further limit the subject matter of the previous apparatus claims in terms of positive structure. Moreover, the term “when” used therein is conditional and futuristic and thus it is not a positive limitation.

### ***Claim Rejections –35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 27-37 and 52-57 are rejected under 35 U.S.C. 102(a) as being anticipated by Totsuka (U.S. Patent 6,051,266). There is disclosed in Totsuka an apparatus for roasting and cooling a mass of green coffee beans, comprising: a pan surface (11) for supporting a mass of green coffee beans, heating device (40) for heating the pan surface for roasting the mass of green coffee beans by heat transfer between the surface and the mass of beans, and airflow means (80) for cooling the mass of roasted beans and removing chaff from the mass of beans. Totsuka also discloses a method of roasting and cooling a mass of coffee beans, comprising: forming a mass of

green coffee beans on a pan surface (II), roasting the mass of coffee beans while they are at rest on the surface by heat transfer from the surface to the mass of beans, cooling the mass of beans, and during the cooling step removing chaff from the mass of beans.

***Claim Rejections – 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 38-45, 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Totsuka (U.S. Patent 6,051,266) in view of Cook, III (U.S. Patent 5,441,344). It would have been obvious to substitute the transparent cover of Cook, III for the cover in Totsuka since it is a mere substitution of one form of covering device for another in the absence of any new or unexpected results.

Claims 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Totsuka (U.S. Patent 6,051,266) in view of Song (U.S. Patent 5,564,331). It would have been obvious to provide the heating device of Totsuka with an electric resistance element to generate hot air for use in heating the pan surface since Song shows the conventional expedient of employing an electric resistance element as a heat source to generate a heated airstream for heating a roasting vessel containing raw coffee beans.

Claims 26 and 57 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tetsuo (Japanese patent 62-58977), Elevitch (U.S. Patent 4,425,720) or Tidland et al (U.S. Patent 5,958,494). Each of the alternative references shows the product set forth in claims 26 and 57.

Alternatively, it is not seen that the claims define an unobvious new product over the product of Tetsuo, Elevitch or Tidland et al. The examiner's position is that irrespective of the process by which the product is made, the claimed product is still a roasted coffee bean product without smoke odor; and such a product is shown by Tetsuo, Elevitch or Tidland et al. It is well settled that the recitation that the product is made by a new process, if the process was indeed new and patentable, does not impart patentability to an otherwise unpatentable product. The burden is upon the applicant to come forward with evidence to prove that the prior art product does In re Brown, 173 USPQ 685; In re Pilkington, 162 USPQ 145; In re Fessman, 180 USPQ 324 (especially 325, last para.); In re Marosi, 710 F. 2d 799, 218 USPQ 195 (Fed. Cir. 1983); and In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985).

#### ***Allowable Subject Matter***

Claims 1-25 are allowed.

Claim 46 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Yeung whose telephone number is (571) 272-1412. The examiner can normally be reached on Monday-Friday from 10:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

G. Yeung/af  
April 19, 2004



**GEORGE C. YEUNG  
PRIMARY EXAMINER**